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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,694	02/22/2002	Alistair Egan	PW 71525 277201	8361

7590 03/26/2004

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EXAMINER

WEST, JEFFREY R

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

9/22

Office Action Summary	Application No.	Applicant(s)	
	10/080,694	EGAN ET AL.	
	Examiner	Art Unit	
	Jeffrey R. West	2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/21/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because of the following informalities:

Figure 2A presents a flow chart of operations. Step "225" however, determines "Is authentication counter > 0?" and subsequently proceeds to a "Yes" path a "No" path and a third, unlabeled, path. It is unclear to one having ordinary skill in the art as to what conditions cause the processing of the third path.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

The labeling of the "electrical counter 140" on page 4, line 9 is confusing since a "counter device 105" and "memory storage device 140" have already been presented.

On page 5, lines 16-18, Applicant refers to step "215" as detecting a "high voltage level" while Figure 2A illustrates the detection of a "non-steady-state signal".

On page 5, line 18 and page 6, line 16, Applicant indicates that an iteration is continued until a counter reaches zero while "225" in Figure 2A and "265" in Figure 2B indicate that an iteration is performed until the counter is > 0.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 includes a limitation for “testing the detected active signal for up to a set number of times, and when the active signal is detected for each of the set number of times during execution of the subroutine, the number stored in the memory device is incremented.” This limitation, however, is not supported by the specification. On the contrary, the disclosed method does not increment the number stored in the memory device “when the active signal is detected for each of the number of times during execution of the subroutine” but instead, as shown in Figure 2A, steps 215-225, an authentication counter is decremented for each of the number of times, and a separate counter is incremented after the iterations are completed.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because it contains a similar limitation for “when the steady-state signal is detected for each of the second

set number of times, the number stored in the memory storage device is incremented” while, as shown in Figure 2B, steps 255-265, a second authentication counter is decremented for each of the number of times, and a separate counter is incremented after the iterations are completed.

Claim 7 is further rejected because the specification does not enable one having ordinary skill in the art how testing a “subsequently detected steady-state signal” is implemented. On page 6, lines 6+, the specification indicates that “after the CPU 150 has verified 225 that a signal was active for a set number of times, the CPU 150 waits until a steady-state voltage signal is detected 240, and begins executing 245 a second authentication program.” As shown in Figure 2A, there is no indication as to when this routine is executed. The program already requires that after the CPU has verified the active signal, it must proceed to step “230” to increment the counter. If, at this point, the program branches to the subsequent routine, the counter will not be incremented. For this reason, one having ordinary skill in the art would not be able to make/use the invention.

Claim 15 is similarly rejected for including a limitation for “testing a subsequent steady-state signal for up to a second set number of times”.

Claim 13 is rejected as not being sufficiently enabled by the specification because the order of operations is not supported. Claim 13 first recites “a method of storing and outputting a count for an imaging device” comprising “storing the count in a memory storage device”, “detecting a continuous active signal . . .”, “receiving a count request . . .”, “incrementing the count in the memory storage device when the

continuous active signal from the input is detected” and “outputting the count to the remote device”. Figure 3 and the corresponding description on page 6 lines 20+, however, do not support this method. In the disclosed method there is no detection or incrementing once a count request is received from a remote device. Therefore, it is unclear how the user can request a count request before the count has been updated.

Claims 2-6, 8-12, 14, and 16-22 are rejected under 35 U.S.C. 112, first paragraph, because they incorporate the lack of enablement present in their respective parent claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, “the subroutine testing the detected active signal for up to a set number of times, and when the active signal is detected for each of the set number of times during execution of the subroutine, the number stored in the memory device is incremented.” This limitation is vague and indefinite because the active signal is not detected for each of the set number of times. The claim first recites “wherein the program code is adapted to detect the active signal of the electrical signal received

by the electrical [signal]-receiving device". This detection is not limited by any set number. It is then a testing of the (i.e. one) active signal that is executed a set number of times. Therefore, it is unclear to one having ordinary skill in the art how to determine the case of when the active signal is detected for each of the set number of times.

Further in claim 1, it is unclear to one having ordinary skill in the art how a memory storage device can store a number representing "a count of the active signals received by the electrical signal-receiving device" when an electrical signal-receiving device only receives "a continuous active signal" (emphasis added).

Claim 7 is rejected under 35 U.S.C. 112, second paragraph for similar limitations of "the subroutine testing the detected active signal for up to a set number of times, and when the active signal is detected for each of the set number of times during execution of the subroutine . . ." and "a memory device to store a number representing a count of the active voltage levels received by the electrical signal-receiving device".

Claim 7 is further rejected as being vague and indefinite because it contains a limitation for "the steady-state signal" (line 15). This limitation is unclear because the claim already presents a "steady-state signal" and a "subsequently detected steady-state signal" and it is unclear to one having ordinary skill in the art to which of these signals "the steady-state signal" refers.

Claims 2-6 and 8-12 are rejected under 35 U.S.C. 112, second paragraph, because they incorporate the lack of clarity present in their respective parent claims.

Claim Objections

7. Claims 1, 7, and 14 are objected to because of the following informalities:

In claim 1, lines 9-10, to avoid problems of antecedent basis, "the electrical pulse-receiving device" should be ---the electrical signal-receiving device---.

In claim 1, 7, and 14, recitations of "the steady-state signal" and "the active signal" should be changed to ---the continuous steady-state signal--- and ---the continuous active signal---, respectively, to avoid problems of antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 4, 5, 7, 8, 10, 11, 13-18, 20, and 21, as may best be understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No.

6,026,380 to Weiler et al. in view of U.S. Patent No. 4,531,826 to Stoughton et al.

Weiler discloses an electrical pulse detection system for an imaging system comprising an electrical signal receiving device to receive an electrical signal at a serial port (column 3, lines 17-25), wherein the electrical signal includes a

continuous steady-state signal (column 3, lines 28-34) and a continuous active signal (column 3, lines 35-40), a code-storage device to store program code (column 2, lines 56-59), a memory storage device to store a number representing a count of the active signals received by the electrical signal-receiving device (column 1, lines 47-49), and a processor to access and execute the program code (column 2, lines 59-61), wherein the program code is adapted to detect the active signal of the electrical signal received by the electrical pulse-receiving device, representing the completion of an imaging job, (column 3, lines 36-47), and further wherein execution of the program causes the remote processor to request a count from the user (column 4, lines 9-21) and to execute a subroutine when the active signal is detected, the subroutine counting the detected active signal for up to a set number of times, and when the active signal is detected for each of the set number of times, the number stored in the memory device is incremented (column 4, lines 9-21 and 35-47).

Weiler also specifies that the code-storage device is a read-only memory (column 2, line 57) and the imaging system is a printing system/copier (column 1, lines 31-34).

Weiler also discloses that the active signal is only detected and counted after the detection of the steady-state enabling signal (column 3, lines 9-16 and column 4, line 64 to column 5, line 5).

Further since, as shown in Figure 3, the steady-state enabling signal is a 5-volt signal and the active signal is a 5-volt signal supplied through a voltage reducing

resistor, it is considered inherent that the steady-state signal and the active signal have different voltage levels.

As noted above, the invention of Weiler teaches many of the features of the claimed invention, and while the invention of Weiler does teach detecting the steady state (i.e. enabling) signal (column 3, lines 60-63) as well as detecting the active signal (column 4, lines 40-41) for each of the predetermined number of copies set by the user (column 4, lines 9-21), the combination does not teach testing the signals each time they are detected.

Stoughton teaches an event counter and access controller for use in a photocopier including means for counting a plurality of pulses of an active signal for determining the completion of an imaging event (abstract) and further including a looping means for repeated testing of the active signal a number of times (i.e. each time they are detected) (column 11, lines 7-21).

It would have been obvious to one having ordinary skill in the art to modify the invention of Weiler to include means for testing the signals received by the signal-receiving device each time they are detected, as taught by Stoughton, because, as suggested by Stoughton, the combination would have insured the accuracy of the counting operation by eliminating the erroneous counting of noise (column 1, lines 43-51).

10. Claims 3, 6, 9, 12, 19, and 22 as may best be understood, are rejected under 35

U.S.C. 103(a) as being unpatentable over Weiler in view of Stoughton and further in view of U.S. Patent No. 5,673,190 to Kahleck et al.

As noted above, the invention of Weiler and Stoughton teaches many of the features of the claimed invention and while the combination teaches using the system/method for a photocopier, it does not specifically describe use of the system/method in a scanning system or a computer printer.

Kahleck teaches a multipurpose remote office machine management system including a signal-receiving device (column 4, lines 58-61) that receives a steady-state enabling signal (column 4, line 66 to column 5, line 1) as well as a plurality of active signals which indicate the completion of an imaging event for incrementing of a counter (column 6, lines 7-14) wherein the device performing the imaging is a scanner, photocopy machine, or computer printer (column 4, lines 39-47).

It would have been obvious to one having ordinary skill in the art to modify the invention of Weiler and Stoughton to include use of the system/method in a scanning system or a computer printer, as taught by Kahleck, because Kahleck suggests that the combination would have allowed use of the invention for a wider variety of applications including a plurality of office machines, thereby controlling printing access in a larger environment (column 1, lines 18-37).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

U.S. Patent No. 5,016,059 to Smeiman teaches a photocopy machine remotely-controlled copy counting system.

U.S. Patent No. 6,484,934 to Salgado teaches a method and apparatus for charging for printing operations on an electrophotographic printing machine.

U.S. Patent No. 6,064,836 to Nakamura et al. teaches an image formation supervisory system and method for controlling the number of times an image is formed under an identification code.

U.S. Patent No. 5,956,557 to Kato et al. teaches an image forming apparatus and method for controlling the number of image forming operations.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. West whose telephone number is (571)272-2226. The examiner can normally be reached on Monday through Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc S. Hoff can be reached on (571)272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2857

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jrw
March 18, 2004


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